

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/820,563  
Applicant : WONG et al.  
Filed : April 8, 2004  
Title : COMPOSITION AND METHOD FOR TREATING GLAUCOMA  
  
TC/A.U. : NA  
Examiner : NA  
  
Docket No. : D-3136 CON1 CIPRE  
Customer No. : 33197

RECEIVED  
CENTRAL FAX CENTER  
SEP 22 2004

Please Deliver to Paul Shanoski, c/o Office of Petitions

CERTIFICATE OF FACSIMILE TRANSMISSION

Mail Stop PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being transmitted via facsimile to Mail Stop PETITION, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, to fax number 703-872-9306, on the date indicated below.

Date: September 22, 2004  
By: Paul Shanoski

RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)

Dear Sir:

This Renewed Petition Under 37 C.F.R. § 1.47(a) is being submitted in response to the Decision on Petition of August 27, 2004 for the above-identified application. A reply to the Decision is due October 27, 2004.

As indicated on page 3 of the Decision, a reply may include a declaration executed by the non-signing inventor. Applicant is submitting herewith the executed Declaration and Petition for Reissue Application signed by the non-signing inventor, Dr. Vernon G. Wong. Also enclosed is an executed Offer to Surrender signed by Dr. Vernon G. Wong.

In view of the above, applicant submits that this Renewed Petition under 37 C.F.R. § 1.47(a) properly and fully responds to the Decision, and that all requirements for filing the above-

BEST AVAILABLE COPY



SEP 22 2004

Confirmation No.

SEP-22-04 11:33AM FROM-StoutXBUYAMM1111

Applicant: WONG et al.  
Serial No.: 10/820,563  
Filed: April 8, 2004  
Page 2 of 5

I have reviewed and understand the contents of the specification, including the claims of the specification, and the claims as presented by the preliminary amendment enclosed herein. I believe that no new matter has been added by the changes set forth in this reissue application.

In accordance with 35 U.S.C. § 251, it is submitted that the original patent is partially inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 1-3 of original claim 1 recite "a method for improving the post-operative success of glaucoma filtration surgery". This language may render the patent partially inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 4-8 of original claim 1 recite "introducing proximal to the surgical site an implant comprising dexamethasone at a concentration from about 40 to 80 weight percent of the implant and poly-lactate glycolic acid copolymer at a concentration of at least 20 weight percent of the implant". This language may render the patent partially inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 9-12 of original claim 1 recite "said therapeutically active agent is released within a therapeutic dosage which does not vary by more than about 100% for a period of at least about 3 weeks". This language may render the patent partially inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 1-3 of original claim 14 recite "a method for improving the post-operative success of glaucoma filtration surgery". This language may render the patent partially

Applicant: WONG et al.  
Serial No.: 10/820,563  
Filed: April 8, 2004  
Page 3 of 5

inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 4-10 of original claim 14 recite "introducing proximal to the surgical site an implant comprising dexamethasone at a concentration from about 40 to 80 weight percent of the implant and poly-lactate glycolic acid copolymer having a relative average molecular weight between about 10 and about 60 kD at a concentration of at least about 20 weight percent of the implant". This language may render the patent partially inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 11-14 of original claim 14 recite "said therapeutically active agent is released with a therapeutic dosage which does not vary by more than about 100% for a period of at least about 3 weeks". This language may render the patent partially inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 1-3 of original claim 18 recite "a method for improving the post-operative success of glaucoma filtration surgery". This language may render the patent partially inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 4-12 of original claim 18 recite "introducing proximal to the surgical site an implant comprising a therapeutically effective agent at a concentration from about 10 to 50 weight percent of the implant, and at least one pharmacologically acceptable biodegradable polymer having a relative average molecular weight between about 10 and 60 kD at a concentration of at least about 20 weight percent of the implant". This language may render the patent partially

Applicant: WONG et al.  
Serial No.: 10/820,563  
Filed: April 8, 2004  
Page 4 of 5

inoperative for claiming less than the patentee had a right to claim in the patent.

Lines 13-16 of original claim 18 recite "said therapeutically active agent is released with a therapeutic dosage which does not vary by more than about 100% for a period of at least about 3 weeks". This language may render the patent partially inoperative for claiming less than the patentee had a right to claim in the patent.

All errors which are being corrected in this reissue application up to the time of filing of this declaration arose without any deceptive intention on the part of myself.

I respectfully request that I may be allowed to surrender the original patent and that Letters Patent may be reissued to me for the same invention upon the above-identified specification.

I hereby appoint as my attorneys and/or agents

Martin A. Vost, Reg. No. 25,208; Robert Baran, Reg. No. 25,806;  
Carlos A. Fisher, Reg. No. 36,510; Stephen Donovan, Reg. No.  
33,433; Brent A. Johnson Reg. No. 51, 851; Dean G. Stathakis  
Reg. No. 54,465; Frank J. Oka, Reg. No. 25,612; Donald E.  
Stout, Reg. No. 34,493; Robert D. Buyan, Reg. No. 32,460;  
Kenton M. Mullins, Reg. No. 36,331; Jo Anne M. Ybaben, Reg. No.  
42,243; Linda Allyson Fox, Reg. No. 38,883; Greg S. Hollrigel,  
Reg. No. 45,374; and Louise S. Heim, Reg. No. 32,337

with full power of substitution and revocation, to transact all business in the Patent and Trademark Office connected with the above-identified application and to receive all correspondence from the Patent and Trademark Office regarding the above-identified application.

I, the undersigned, declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that

Applicant: WONG et al.  
Serial No.: 10/820,563  
Filed: April 8, 2004  
Page 5 of 5

willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Full name of sole or first inventor (given name, family name):

WONG, VERNON

Inventor's signature *Vernon Wong*  
Residence: Menlo Park, CA  
Mailing Address: 180 Sand Hill Circle  
Menlo Park, CA 94025

Date: 9/2/04  
Citizenship U.S.

Full name of second joint inventor (given name, family name)

PENG, Lin

Inventor's signature \_\_\_\_\_ Date: \_\_\_\_\_  
Residence: South San Francisco, CA Citizenship U.S.  
Mailing Address: 400 Oyster Point Blvd, Suite 505  
South San Francisco, CA 94080

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/820,563 Confirmation No.  
Orig Pat No. : 6,369,116  
Applicant : WONG et al.  
Filed : April 8, 2004  
Title : COMPOSITION AND METHOD FOR TREATING GLAUCOMA

TC/A.U. : NA  
Examiner : NA

Docket No. : D-3136 CON1 CIPRE  
Customer No. : 33197

Mail Stop REISSUE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

OFFER TO SURRENDER

Dear Sir:

We, Vernon Wong and Lin Peng, inventors named in United States Patent No. 6,369,116, which issued April 9, 2002 for COMPOSITION AND METHOD FOR TREATING GLAUCOMA, hereby offer to surrender said patent in accordance with 37 C.F.R. 1.178.

  
\_\_\_\_\_  
Vernon Wong

Date: 9-2-04

\_\_\_\_\_  
Lin Peng

Date: \_\_\_\_\_